

REMARKS

Claims 3-8, 10, 11, 13-16, 18-25, 28, 30, 32-35, 37-40, and 42-45 are currently pending in this application. Claims 4, 5, 8, 10, 11, 13-16, 18-25, 28, 30, 32-35, 38, and 42-44 have been amended to further clarify certain features of these claims without disclaimer of or prejudice to pursuing the subject matter of these claims in unamended form in a continuation, divisional, or other application. No claims have been added or cancelled.

In the Office Action mailed October 27, 2009, pending claims 3-8, 10, 11, 13-16, 18-25, 28, 30, 32-35, 37-40, and 42-45 were rejected. More specifically, the status of the application in light of this Office Action is as follows:

(A) Claims 3, 4, 10, 11, 13, 14, 19-23, 25, 28, 30, 32-35, and 38-40 were rejected under 35 U.S.C. § 103(a) over the combination of U.S. Patent No. 6,594,690 to Cantwell ("Cantwell") and U.S. Patent No. 6,459,499 to Tomat ("Tomat");

(B) Claims 5-8, 15, 16, 18, and 37 were rejected under 35 U.S.C. § 103(a) over the combination of Cantwell, Tomat, and U.S. Pat. No. 6,785,805 to House et al. ("House");

(C) Claim 24 was rejected under 35 U.S.C. § 103(a) over the combination of Cantwell, Tomat, and U.S. Pat. No. 5,587,533 to Schneider et al. ("Schneider"); and

(D) Claims 42-45 were rejected under 35 U.S.C. § 103(a) over the combination of U.S. Pat. No. 7,120,910 to Matsuda et al. ("Matsuda") and Cantwell.

A. Response to the Section 103(a) Rejection of Claims 3, 4, 10, 11, 13, 14, 19-23, 25, 28, 30, 32-35, and 38-40 (Cantwell and Tomat)

Claims 3, 4, 10, 11, 13, 14, 19-23, 25, 28, 30, 32-35, and 38-40 were rejected under 35 U.S.C. § 103(a) over the combination of Cantwell and Tomat. As set forth below, the applied references cannot support a Section 103 rejection of claims 3, 4, 10,

11, 13, 14, 19-23, 25, 25, 28, 30, 32-35, and 38-40 for at least the reason that these references fail to teach or suggest all the claimed features.

As discussed during the January 20th telephone conference, independent claim 25 recites, *inter alia*, a destination selection system that is "configured to insert a destination address of the selected location for saving the scanning data in a self-extracting executable file." The self-extracting executable file also includes the selected driver. Claim 25 also recites that the server is "configured to transfer the self-extracting executable file to the computer."

The applied references do not teach or suggest a destination selection system that is "configured to insert a destination address of the selected location for saving the scanning data in a self-extracting executable file." The Office Action asserts that Figure 7 of Tomat and the corresponding description constitutes certain features of claim 25. (Office Action, pp. 5 and 6.) The applicant respectfully disagrees with this assertion. As discussed during the January 20th telephone conference, Figure 7 of Tomat illustrates an add/edit profile window that allows a user to add or edit their profile. (Tomat, col. 9, lines 26-30.) Tomat describes that a user can specify a temporary file location and other aspects of an image file in block 133 as part of their user profile 50. (*Id.* at col. 9, lines 48-59 and col. 10, lines 12-25.) Tomat further describes that the user profiles 50 are stored on a fixed disk 15 of a computer system 2 to which the scanner 1 is attached. (*Id.* at col. 9, lines 6-9; *see also* Tomat, Figure 2.) Alternately, the user profiles 50 are stored on a network disk 83 attached to a server 68. (*Id.* at col. 9, lines 15-20; *see also* Tomat, Figure 3.)

However, Tomat does not teach or suggest that the user profiles, regardless of where they are stored, constitute a self-extracting executable file. Rather, Tomat describes that the user profiles are stored either as text or in encoded form. (*Id.* at col. 9, lines 6-9.) A user profile stored either as text or in encoded form does not constitute a self-extracting executable file that may be executed by a computer to extract a destination address. The Office Action appears to suggest that because Tomat

describes that the user profile may be stored on a central server, this corresponds to a self-extracting executable file. (Office Action, p. 6.) The applicant respectfully disagrees. Storing a user profile in a different location does not change the nature of the user profile; rather, it is still stored either as text or in encoded form. Because Tomat only describes storing a specified file location in a user profile, Tomat does not teach or suggest inserting a destination address in a self-extracting executable file and transferring the destination address, along with the driver, to the computer.

Accordingly, Tomat fails to teach or suggest a destination selection system that is "configured to insert a destination address of the selected location for saving the scanning data in a self-extracting executable file," as recited in claim 25. Moreover, Cantwell fails to cure the deficiencies of Tomat to support a Section 103 rejection of claim 25. For at least these reasons, the Section 103 rejection of claim 25 should be withdrawn. During the January 20th telephone conference, the Examiner indicated that he would carefully further review Cantwell and Tomat in view of these remarks. Accordingly, the applicants respectfully request that the Examiner reconsider and withdraw the Section 103 rejection of claim 25.

Claims 3, 4, 10, 11, 21, 32, and 33 depend from base claim 25. Accordingly, the Section 103 rejection of claims 3, 4, 10, 11, 21, 24, 32, and 33 should be withdrawn for at least the foregoing reasons, and for the additional features of these dependent claims.

Independent claims 28, 30, and 38, as amended, recite several features generally similar to those of claim 25 (e.g., a destination selection system that is configured to insert a destination address of the selected location for saving the scanning data in a self-extracting executable file). Accordingly, claims 28, 30, and 38 are patentable over Cantwell and Tomat for at least the reasons discussed above with respect to claim 25, and for the additional features of these independent claims. Therefore, the Section 103 rejection of claims 28, 30, and 38 should be withdrawn.

Claims 13, 14, 22, and 23 depend from base claim 28, claims 19, 20, 34, and 35 depend from base claim 30, and claims 39 and 40 depend from base claim 38. Accordingly, the Section 103 rejection of claims 13, 14, 19, 20, 22, 23, 34, 35, 39, and 40 should be withdrawn for at least the foregoing reasons, and for the additional features of these dependent claims.

B. Response to the Section 103(a) Rejection of Claims 5-8, 15, 16, 18, and 37 (Cantwell, Tomat, and House)

Claims 5-8, 15, 16, 18, and 37 were rejected under 35 U.S.C. § 103(a) over the combination of Cantwell, Tomat, and House. Claims 5-8 depend from base claim 25, claims 15 and 16 depend from base claim 28, claim 18 depends from base claim 30, and claim 37 depends from base claim 38. House is relied on in the Office Action for describing "a login system adapted to enable said user to access said driver selection system following establishing an identity of the user." (Office Action, pp. 9 and 10.) Even assuming for the sake of argument that this is correct (and the applicant expressly does not), House fails to cure the above-noted deficiencies of Cantwell and Tomat to support a Section 103 rejection of base claims 25, 28, 30, and 38. Accordingly, claims 5-8, 15, 16, 18, and 37 are allowable over the combination of Cantwell, Tomat, and House for at least the reason that these references, either alone or in combination, fail to disclose or suggest the features of claims 25, 28, 30, and 38, and the additional features of these dependent claims. Therefore, the Section 103 rejection of dependent claims 5-8, 15, 16, 18, and 37 should be withdrawn.

C. Response to the Section 103(a) Rejection of Claim 24 (Cantwell, Tomat, and Schneider)

Claim 24 was rejected under 35 U.S.C. § 103(a) over the combination of Cantwell, Tomat, and Schneider. Claim 24 depends from base claim 25. Schneider is relied on in the Office Action for describing "scanned data that is stored under a user defined file name and the user is queried if the scanned data is to be saved or not." (Office Action, p. 11) Even assuming for the sake of argument that this is correct (and the applicant expressly does not), Schneider fails to cure the above-noted deficiencies

of Cantwell and Tomat to support a Section 103 rejection of base claim 25. Accordingly, dependent claim 24 is allowable over the combination of Cantwell, Tomat, and Schneider for at least the reason that these references, either alone or in combination, fail to disclose or suggest the features of corresponding base claim 25, and the additional features of this dependent claim. Therefore, the Section 103 rejection of dependent claim 25 should be withdrawn.

D. Response to the Section 103(a) Rejection of Claims 42-45 (Matsuda and Cantwell)

Claims 42-45 were rejected under 35 U.S.C. § 103(a) over the combination of Matsuda and Cantwell. As set forth below, the applied references cannot support a Section 103 rejection of claims 42-45, for at least the reason that these references fail to teach or suggest all the claimed features. For example, independent claim 42 recites "transferring the selected scanner driver to the second computer, wherein transferring the selected scanner driver to the second computer includes transferring the selected scanner driver in a self-extracting file to the second computer, and wherein the selected location is also included in the self-extracting file." According to the Office Action, Cantwell describes these features at col. 2, lines 54-58: (Office Action, pp. 13 and 14.) The applicant respectfully disagrees with this assertion.

Cantwell actually describes that the user's browser browses a website containing drivers for a device. (Cantwell, col. 2, lines 20-27.) The browser downloads and executes executable code, which installs any required software on the user's client. (*Id.* at col. 2, lines 45-48.) The executable code then spawns a setup and configuration utility on the client, and information about the device is communicated to the executable code. (*Id.* at col. 2, lines 54-56.) The executable code uses this information to select a driver for the device. (*Id.* at col. 3, lines 3-7.) Once a driver is selected, it is downloaded and installed. (*Id.* at col. 3, lines 8-10.) Based on the undersigned's review of Cantwell, this reference contains no teaching or suggestion that the driver is provided as a self-extracting file. Moreover, Cantwell does not teach or suggest selecting a

location for storing scanning data. Accordingly, Cantwell does not teach or suggest transferring a self-extracting file that includes a driver or a location. Applicant respectfully notes that the Office Action acknowledged that Cantwell does not teach or suggest similar features recited in claim 25. (See Office Action, p. 5, stating that Cantwell does not explicitly disclose a destination selection system configured to insert a destination address of a selected location for saving scanning data in a self-extracting executable file.) Moreover, Matsuda fails to cure the deficiencies of Cantwell to support a Section 103 rejection of claim 42. For at least these reasons, the Section 103 rejection of claim 42 should be withdrawn.

Claims 43-45 depend from base claim 42. Accordingly, the Section 103 rejection of dependent claims 43-45 should be withdrawn for at least the foregoing reasons, and for the additional features of these dependent claims.

Conclusion

In view of the foregoing, the pending claims comply with the requirements of 35 U.S.C. § 112 and are patentable over the applied art. The applicants accordingly request reconsideration of the application and a mailing of a Notice of Allowance. If the Examiner has any questions or believes a telephone conference would expedite prosecution of this application, the Examiner is encouraged to contact Joseph F. Brennan at (206) 359-6065.

Respectfully submitted,

Perkins Coie LLP



Joseph F. Brennan
Registration No. 62,403

Date: March 1, 2010

Correspondence Address:

Customer No. 25096
Perkins Coie LLP
P.O. Box 1247
Seattle, Washington 98111-1247
(206) 359-8000